REMARKS

This response is submitted in response to the Final Office Action dated May 25, 2004, and respectfully requests that the Examiner reconsider the rejection of the claims as set forth therein. In the event that the Examiner determines that the foregoing Amendments do not place the application in condition for allowance, it is respectfully requested that the foregoing Amendments be entered to place the claims in better form for consideration upon appeal.

This Final Rejection is in reply to the Applicant's Response Under 37 C.F.R. 1.111 filed on March 4, 2004 to the non-final Office Action of December 5, 2003.

At the outset, prior to addressing the rejections over the prior art, the applicant calls to the Examiner's attention that claim 10 has been amended to make a minor editorial correction by adding as the very first word --A method of fabrication a flexible board,--, which was erroneously omitted. No new matter has been added.

In the Office Action of December 5, 2003, claims 2-6, 8-12 and 14-18 were rejected under 35 U.S.C. 103(a) allegedly as being unpatentable over Eda et al (US 5,387,888 - filed April 1, 1993 - issued February 7, 1995) in view of Suzuki et al (US 4,707,671 - filed May 9, 1986 - issued November 17, 1987).

In the applicant's Response filed on March 4, 2004, claims 4, 10 and 16 were amended to define the ground line based on FIG. 1. The applicant argued that support for the amendments to claims 4, 10 and 16 is found in FIG. 1 which

discloses that the ground line 10 is the combination of the first ground layer 1, the internal layer 2, and the second ground layer 3.

Now in the Final Rejection, the Examiner rejects claims 2-6, 8-12 and 14-18 under 35 U.S.C. 102(b) allegedly as being anticipated by Eda et al. The Suzuki et al reference has been removed in view of the amendment. The alleged basis for the rejections is otherwise very similar to those presented by the Examiner in the Office Action of December 5, 2003.

In the Response to Arguments, the Examiner asserts that *the preambles* of claims 4, 10 and 16 now recite "a ground line, said ground line comprising". The Examiner takes the position of not giving patentable weight to this limitation because the limitation occurs in the preamble.

The Examiner cites two court decisions to state "A preamble is not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao,* 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie,* 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951)"

In response, the applicant respectfully disagrees with the Examiner's position for the following reasons:

1. The limitation of "a ground line" is not a part of the preamble. It is "A flexible board" that is part of the preamble.

2. Even if the ground line were part of the preamble, the Examiner has failed to fully consider those portions of *Hirao* and *Kropa* that are favorable to the applicant's position. Namely, the Examiner has failed to consider those portions of the very same decisions which indicate that the preamble can be a limitation which distinguishes over the prior art.

In particular, in *Kropa v. Robie,* page 481, it is indicated as follows:

> "....On the other hand, in those ex parte and interference cases where the preamble to the claim or count was expressly or by necessary implication given the effect of a limitation, the introductory phrase was deemed essential to point out the invention defined by the claim or count. In the latter class of cases, the preamble was considered necessary to give life, meaning, and vitality to the claims or counts. Usually, in those cases, there inhered in the article specified in the preamble a problem which transcended that before prior artisans and the solution of which was not conceived by or known to them. The nature of the problem characterized the elements comprising the article, and recited in the body of the claim or count following the introductory clause, so as to distinguish the claim or count over the prior art...."

Therefore, the applicant maintains that for the foregoing reasons, the Examiner has improperly denied giving patentable weight to the limitations of: -- A

flexible board comprising a ground line, said ground line comprising:-- in claim 4; -- A method of fabricating a flexible board, comprising the steps of forming a ground line by:-- in claim 10; and -- A cellular phone including a flexible board, said flexible board comprising a ground line comprised of:-- in claim 16.

The applicant reiterates that the limitations of claims 4, 10 and 16 recite a ground line comprising a first ground layer, an internal layer, and a second ground layer. In contrast, Eda et al disclose a dielectric layer, referred to as second dielectric layer 2', between top ground electrode 3 and electrical conduction line 7 and 7', and a first dielectric layer 2 between electrical conduction line 7 and 7' and bottom ground electrode 4, but not a ground line comprising a first ground layer, an internal layer, and a second ground layer.

Suzuki et al disclose only a film-shaped porous dielectric 2 between a plurality of pairs of signal lines 1a1,..., 1g2 and ground lines 1a3...1g3.

Therefore, neither Eda et al nor Suzuki et al, taken alone or in combination, disclose, teach or suggest the limitations of claims 4, 10 and 16 of a ground line comprising a first ground layer, an internal layer, and a second ground layer. As a result, claims 4, 10 and 16 patentably distinguish over the prior art. Consequently, the applicant respectfully requests that the Examiner withdraw the rejections of claims 2-6, 8-12 and 14-18 over the prior art.

In view of the foregoing Remarks, the applicant respectfully requests that the Examiner enter this amendment. The foregoing Remarks establish the patentability of all of the claims remaining in the application, i.e., claims 2-6,

8-12, and 14-18. No new matter has been added, wherefore, early and favorable reconsideration and issuance of a Notice of Allowance are respectfully requested.

Respectfully submitted,

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